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10/584,788	06/28/2006	Oliver Winzenried	125542-1006	5003
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GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761			EXAMINER	
			COPPOLA, JACOB C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,788	<b>Applicant(s)</b> WINZENRIED ET AL.
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 August 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11,13-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11, 13-28, 31-34, and 36-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicants' submission filed on 18 August 2009 has been entered.

### ***Acknowledgements***

2. This action is in reply to the amendments to the claims and remarks filed on 18 August 2009 ("09 Aug Response").
3. Claims 11, 13-34, and 36-42 are currently pending.
4. Claims 11, 13-28, 31-34, and 36-42 have been examined.
5. Claims 29 and 30 were previously withdrawn in the Office action mailed on 12 August 2008 (see ¶ 15, Paper No. 20080809).
6. This Office Action is given Paper No. 20091102. This Paper No. is for reference purposes only.

***Claim Rejections - 35 USC §112, 2<sup>nd</sup> Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11, 13-28, 31-34, and 36-42 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

***Regarding Claims 11, 21, and 34***

9. Claim 11 recites “the security file belonging to the authorization code and containing the license parameters but does not contain the authorization code.” Claim 11 is indefinite because it is unclear how the code “belongs” to the file. Is the code in possession of the file? Or is the code related to the file in a different manner?

10. Claim 21 is rejected on the same basis as directly above.

11. Claim 11 recites “a device-specific format that can be read by the dongle but not by the licensee computer.” Claim 11 is indefinite because one of ordinary skill in the art would not be able to determine the scope of the recited format. It is unclear how the format is “device-specific.” Is it specific to a particular dongle or to dongles in general? Or is the format a cryptographic format that can only be interpreted by the dongle because the dongle possesses specific keys?

12. Claims 21 and 34 are rejected on the same basis as directly above.

***Regarding Claim 34***

13. Claim 34 recites “reading of license parameters from a file associated with the authorization code containing the license parameters.” Claim 34 is indefinite because it is unclear whether the file contains the license parameters or the authorization code contains the license parameters.

14. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC §103***

15. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 11, 13-19, 21-27, 31-34, and 36-41, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Downs et al. (U.S. 6,226,618 B1) (“Downs”), in view of Buchheit et al. (U.S. 2002/0031222 A1).

***Regarding Claims 11 and 31-34***

17. Downs discloses:

reading license parameters belonging to a licensor from a security file (“Store Usage Conditions 519” are read from the “Offer SC(s) 641”), stored on the first computer (inherent to receiving the “Offer SC(s) 641”), the security file belonging to the authorization code and containing the license parameters (c. 23, l. 56 – c. 24, l. 62);

sending the read license parameters to a second computer (c. 23, l. 56 – c. 24, l. 62);  
after sending the license parameters, receiving an authorization code at the first computer in a device-specific format (c. 23, l. 56 – c. 24, l. 62); and

storing the authorization code in the first computer (c. 23, l. 56 – c. 24, l. 62, inherent to receiving the code).

18. Downs does not directly disclose:

the security file does not contain the authorization code;  
a device-specific format that can be read by the dongle but not by the licensee computer;  
and

storing the authorization code in the dongle connected to the first computer.

19. Downs suggests that the authorization code can be sent to the clearinghouse apart from the security file (c. 18, at Step 125). Accordingly, separating the authorization code from the security file does not depart from the scope of Down’s invention because the clearinghouse is the only entity that can decrypt the authorization code. The manner in which it arrives at the clearinghouse is immaterial.

20. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the security file of Downs so that it does not contain the authorization code. One would have been motivated to do so because by removing the authorization code from the security file and sending it directly to the clearinghouse, the exposure of the code to the end-user is reduced until access to the code has been granted for the end-user.

21. Additionally, the Examiner notes that as a matter of law, the use of a two piece construction instead of the one structure disclosed in the prior art would be a matter of obvious design choice. In other words, as a matter of law, it is not inventive to separate a single structure in the prior art and make them two, separable pieces. MPEP § 2144.04 *V. C.*

22. Buchheit teaches:

a device-specific format that can be read by a dongle but not by a computer, wherein the dongle is connected to the computer (¶ 0059-0061); and

storing an authorization code in the dongle connected to the computer (¶ 0059-0061).

23. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the format of the authorization code, as disclosed in Downs, to the format that can be read only by a dongle, as taught by Buchheit, and subsequently store the authorization code in the dongle connected to the computer, also taught by Buchheit. One would have been motivated to do so because the use of a Buchheit's dongle, including receiving and storing an authorization code in dongle specific format, prevents an attacker from decoding the data transmitted by the licensor (Buchheit, ¶ 0023).

24. With respect to claim 32, Buchheit further teaches that the authorization code is storable only on the access-protected data processing device (¶ 0059-0061).

*Regarding Claims 13-19, 21-27, and 36-41*

25. The combination of Downs and Buchheit discloses the limitations of claim 11, as shown above, and further discloses the limitations of:

Claims 13, 22, and 36: The method according to claims 11, 21, and 34, characterized in that the license parameters are signed with time information for protection and are provided at least partially in encrypted form in the security file (Downs, c. 13, l. 48+, and c. 81);

Claims 14 and 21: The method according to claim 11 further comprising: receiving the license parameters at the second computer; evaluating the license parameters; and deciding with the second computer whether the requested authorization code should be returned to the first computer (c. 23, l. 56 – c. 24, l. 62);

Claims 15, 23, and 37: The method according to claims 11, 21, and 34, further comprising: communicating time information stored in the security file to the second computer; evaluating the time information at the second computer; and generating an authorization code corresponding to the time information (see “Order Secure Container **650** Format,” c. 35, l. 52+);

Claim 16, 24, and 38: The method according to claims 11, 21, and 34, characterized in that several authorization codes for licenses of several licensors are stored on the dongle (Buchheit, fig. 1 and ¶ 0017, 0025, and 0040);

Claims 17, 25, and 39: The method according to claims 11, 21, and 38, characterized in that remote data connections are established to a computer associated with each of the several

licensors, in order to permit the corresponding authorization codes to be restored (fig. 1 with associated text);

Claims 18, 26, and 40: The method according to claims 11, 21, and 34, further comprising: establishing a remote data connection between the first computer and a central management computer (connection between end-user and digital content store) (fig. 6); sending the security file to the management computer (fig. 1B); and establishing a data connection between the second computer and the management computer (fig. 6); and

Claims 19, 27, and 41: The method according to claims 18, 26, and 34, further comprising: establishing a remote data connection between the first computer and the second computer (fig. 6).

26. Claims 20, 28, and 42, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Downs and Buchheit, and in further view of Heer et al. (U.S. 5,999,629 A) ("Heer").

***Regarding Claims 20, 28, and 42***

27. The combination of Downs and Buchheit discloses the limitations of claims 11, 21, and 34, as shown above.

28. The combination of Downs and Buchheit does not directly disclose reading the serial number from the security file; sending the serial number to a management computer; and storing the serial number in a block list at the management computer.

29. Heer teaches:

reading a serial number of a security device from a memory (c. 7, l. 66 – c. 8, l. 20);  
sending the serial number to a management computer (c. 7, l. 66 – c. 8, l. 20); and  
storing the serial number in a block list at the management computer (c. 7, l. 66 – c. 8, l.  
20).

30. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include the method of Heer in the method of the combination of Downs and Buchheit. One would have been motivated to do so because the method of Heer prevents the use of a lost or stolen security device (Heer, c. 7, l. 66 – c. 8, l. 20).

***Claim Interpretation***

31. Since the application currently before the Examiner is a utility patent, the claims must be directed to systems, methods, or articles of manufacture that have a clear utility. See MPEP 706.03(a). Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and therefore do not serve as a limitation on the claims to distinguish over the prior art. Thus, the limitations on the claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (bdPatApp&Int 1985) and *In re Lowry*, 32

USPQ2d 1031 (CAFC 1994), where language provided certain limitations because of specific relationships required by the claims. In the computer arts we frequently examine claims that are directed to systems, methods, and articles (computer program products) that process data. In these specific cases, nonfunctional descriptive material is material that cannot exhibit any functional interrelationship with the way in which computing processes are performed.

32. As a result, when analyzing claim language for its limited effect, the Examiner will perform two basic steps:

- a. Review the claimed as a whole to see whether or not any descriptive material is being recited; and
- b. If a descriptive material is found, determine how this descriptive material is being used in the claim as a whole.

33. In this case, the claim language contains nonfunctional data in the form of a security file containing license parameters but not containing an authorization code. This nonfunctional data is not processed by the computer, nor does it alter the process steps. It only means something to the human mind. Therefore, this nonfunctional data does not distinguish the claimed invention over the prior art.

34. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

interpretation of the claims.<sup>1</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- c. *belong* “3. To have in one’s possession.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;
- d. *device* “A generic term for a computer subsystem.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997;
- e. *receive* “vb. To accept data from an external communications system, such as a local area network (LAN) or a telephone line, and store the data as a file.” Computer Dictionary, 5<sup>th</sup> Edition, Microsoft Press, Redmond, WA, 2002; and
- f. *subsystem* “(3) (software) A secondary or subordinate system with a larger system.” IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Edition, IEEE, Inc., New York, NY, Dec. 2000.

#### *Response to Arguments*

35. Applicants’ arguments with respect to claim the examined claims have been considered but are moot in view of the new grounds of rejection.

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<sup>1</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

***Conclusion***

36. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).
37. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.
38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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Patent Examiner, Art Unit 3621  
November 4, 2009

/Calvin L Hewitt II/  
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